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In re Patent Application of

INGHARDT et al

Atty. Ref.: 3525-71

Serial No. 09/509,032

Group: 1626

Filed: March 21, 2000

Examiner: Saeed, K.A.

For: NEW AMIDINO DERIVATIVES AND THEIR USE AS THROMBIN INHIBITORS

* * * * *

March 22, 2002

Assistant Commissioner for Patents
Washington, DC 20231

Sir:

In response to the Official Action mailed February 2, 2002, the Applicants hereby elect Group IV (the compounds in which R_x is a structural fragment of formula IIa and B represents a structural fragment of formula IIIa). The election is made with traverse.

The Examiner alleges that the structural moiety common to Groups I to VI is the group depicted on page 4 of the restriction requirement. The Examiner reasons that, because this group is known in the art, it cannot be said to be a special technical feature within the meaning of Rule 13 PCT.

Rule 13.2 PCT states that:

"the expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, **considered as a whole**, makes over the prior art" (emphasis added).

The Examiner reasoning is flawed in that it isolates one particular structural feature of generically defined compounds and takes this in isolation to allege that there is a lack of unity of invention under the PCT rules. It is respectfully believed that the Examiner's position is erroneous.

The claimed compounds of the invention comprise several structural moieties which, when "**considered as a whole**" (see above), together define a special technical feature which distinguishes the subject invention over the prior art. In the present case, it is not correct to take one isolated part of the molecule and allege that this is the part of the molecule that provides a common special technical feature. Rather, it is a **combination** of features that defines the subject invention over the prior art.

A further factor which is believed to be significant is the fact that, if the restriction requirement is maintained, the applicants will be forced to submit seven divisional applications to cover the non-elected subject matter. It is believed that such an outcome would be inequitable in requiring the applicants to incur significant expense in the face of a restriction requirement such as that in the present case. To require patent applicants to carve up their applications in

this way is not the philosophy which underlies restriction requirement practice in the U.S. Patent and Trademark Office. MPEP Section 803 states that:

"If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions."

In this regard, it is noted that Groups II through VIII are classified *inter alia* in Classes 544 and 546, and Group I is classified in Class 548. Thus, it is believed that no significant additional searching or examination burden arises to include the compounds of Groups I-III and V-VIII with the elected Group IV, since the Examiner will be searching Classes 544, 546 and 548 with respect to Group IV. Withdrawal of the restriction requirement for this reason alone is believed to be in order, and is requested.

The Examiner has identified two further groups (VII and VIII). This is not understood in the light of the Examiner's quotation from the PCT rules (the italicized section at the foot of page 2 of the action), which clearly states that:

"(i) in addition to an independent claim for a given product, an independent claim for a process specially adapted for the manufacture of the said product and an independent claim for the use of said product,...";

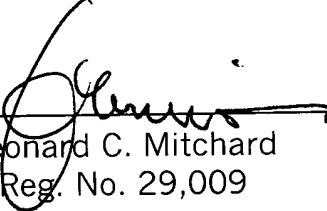
may co-exist in the same application. Indeed, at the foot of page 4, the Examiner appears to be stating that the method of use and process of preparation claims will be examined along with the elected invention insofar as

they are commensurate in scope therewith. In light of this, it is believed that the claims of Groups VII and VIII should be included with the elected group for examination on the merits.

Respectfully submitted,

NIXON & VANDERHYE P.C.

By: _____


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Atty Dkt. 3525-71

C# M#

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Group Art Unit: 1626

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Assistant Commissioner for Patents

Washington, DC 20231

Sir:

RESPONSE/AMENDMENT/LETTER

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

Fees are attached as calculated below:

Total effective claims after amendment previously paid for	24	minus highest number 0 x \$ 18.00	\$	0.00
Independent claims after amendment previously paid for	1	minus highest number 0 x \$ 84.00	\$	0.00
If proper multiple dependent claims now added for first time, add \$280.00 (ignore improper)			\$	0.00
Petition is hereby made to extend the current due date so as to cover the filing date of this paper and attachment(s) (\$110.00/1 month; \$400.00/2 months; \$920.00/3 months)			\$	0.00
Terminal disclaimer enclosed, add \$ 110.00			\$	0.00
<input type="checkbox"/> First/second submission after Final Rejection pursuant to 37 CFR 1.129(a) (\$740.00) <input type="checkbox"/> Please enter the previously unentered , filed <input type="checkbox"/> Submission attached			\$	0.00
		Subtotal	\$	0.00
If "small entity," then enter half (1/2) of subtotal and subtract <input type="checkbox"/> Applicant claims "small entity" status. <input type="checkbox"/> Statement filed herewith			-\$	0.00
Rule 56 Information Disclosure Statement Filing Fee (\$180.00)			\$	0.00
Assignment Recording Fee (\$40.00)			\$	0.00
Other:				0.00
		TOTAL FEE ENCLOSED	\$	0.00

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

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Signature: _____

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